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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/641,350	08/14/2003	Christopher Kempson Shaw	194-26936-US	9812
24923	7590	01/18/2006		
PAUL S MADAN MADAN, MOSSMAN & SRIRAM, PC 2603 AUGUSTA, SUITE 700 HOUSTON, TX 77057-1130			EXAMINER BOMAR, THOMAS S	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/641,350

Applicant(s)

SHAW ET AL.

Examiner

Shane Bomar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-32 and 34-42 is/are rejected.
- 7) ☒ Claim(s) 11 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: the amendment to part c) states that the fluid is pumped into the production fluid; it appears that the Applicant meant to use state that the chemical is pumped into the production fluid, which is how I've interpreted the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10, 12-14, 16-32, 34-42 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6,772,840 to Headworth.

Headworth discloses a system and associated flow assurance method for injecting one or more additives into production fluid produced by at least one subsea well, the system comprising: a) an inherent surface chemical supply unit for supplying at least one chemical to a selected subsea location (inherent because the chemicals must come from the surface before being introduced subsea); b) at least one chemical supply line 80, 70 for carrying the at least one chemical from the surface to the selected subsea location; and c) a subsea chemical injection unit 70 at the selected subsea location receiving the at least one chemical from the surface chemical

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supply unit and selectively injecting the at least one chemical into the production fluid (see Figs. 2, 3, 5, 7, 11-13, and 16, and col. 6, line 42 through col. 8, line 62). The system further comprising: a controller, or control valve, responding to a parameter of interest from a sensor, or a plurality of distributed sensors (see col. 16, line 56 through col. 17, line 3, and col. 28, lines 14-20); an inherent storage unit for the chemicals since the line 70 is said to hold the chemicals in one embodiment (see col. 28, lines 22-24), and wherein the storage unit is adapted to be refilled remotely; a plurality of lines 701 and 71 supply a plurality of chemicals (see col. 12, lines 30-32); the chemical supply unit can be on a rig (see Fig. 3), or on a buoy (see Fig. 2 where 42 acts like a buoy, or Fig. 14), wherein it would be inherent that the chemicals are stored in some type of unit for supplying the supply unit, and that if the chemical supply becomes depleted but the operations still require the chemicals, then the storage unit would be refilled when such a need arose; it is seen to be inherent that some form of mixer would be needed to mix more than one chemical together before being injected; conductors 104 supply power, and can be seen as a subsea power unit for the injector, especially since the valves 194 of the tubing must be powered (see col. 16, lines 48-49); a riser transports the production fluid and the chemical supply line is in the riser (see Figs. 2, 3, 5, 7, 11-13, and 16), or it could be outside, as is old in the art (see col. 27, lines 27-31); the sensor is located at least one of the claimed locations (see col. 16, line 56 through col. 17, line 21); there are a plurality of wells 52 and the injection unit separately supplies the wells (see Figs. 3, 11, and 16); a subsea processing unit 69 receives production fluid via line 56 (see Fig. 2); the injection unit injects chemicals into at least one of the currently claimed elements (see Figs. 2-16); line 70 also acts as a heating device to heat the production fluid with an inherent source of power (see col. 11, lines 11-14); a surface controller remotely

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controls the valves 194 (see col. 28, lines 14-20); and the processing unit at least partially refines the production fluid as is well known in the art, and transports it to the surface via a fluid line (see col. 10, lines 28-63). The method also inherently measures a parameter of interest because it is well known in the art that fiber optic line sensors take these types of measurements.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Headworth in view of US patent 6,281,489 to Tubel et al.

Headworth teaches the system of claim 14 that comprises a subsea power unit. However, it is not expressly taught that the power unit includes an electrical battery that is periodically charged from the surface.

Tubel et al teach a system for injecting chemicals to treat a production fluid and the use of batteries in the subsurface wellbore environment as a power source. It is further taught that the batteries are periodically charged from the surface (see col. 19, lines 11-19). It would have been obvious to one of ordinary skill in the art, having the teachings of Headworth and Tubel et al before him at the time the invention was made, to modify the system taught by Headworth to include the subsurface rechargeable battery power supply of Tubel et al, in order to obtain an alternate power source that is easily replenishable. One would have been motivated to make

such a combination for the aforementioned reason, and because Tubel et al have shown it to be notoriously known in the art to use rechargeable batteries in the well art as power supplies.

Allowable Subject Matter

6. Claims 11 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed November 9, 2005 with respect to the Headworth reference have been fully considered but they are not persuasive. The Applicant has amended the independent claims to include the limitation that the chemical is pumped into the production fluid. This limitation appears to be redundant since, to one of ordinary skill in the art, the limitation of injecting the chemical into the fluid already encompasses the concept of pumping. Nevertheless, Headworth clearly discloses the fact that the line 70 is used as a chemical injection unit that has chemicals pumped down through it to be injected into the produced fluids in conduit 50 (see col. 27, lines 20-30). Therefore, I respectfully assert that the arguments are traversed and Headworth is still valid as prior art over the above rejected claims.

8. Applicant's arguments, see pages 11-14, filed November 9, 2005, with respect to the Kohl, Smith, and Chen references have been fully considered and are persuasive. The rejections in view of these references have been withdrawn.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb 
January 11, 2006